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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,686	12/05/2000	Christopher D. Casscells,	17616-845	9312

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EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,686

Applicant(s)

CASSCELLS ET AL.

Examiner

Rosiland S Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-13,18,20,24-27,35 and 37-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-13,18,20,24-27,35 and 37-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page 2 paragraph 3 lines 3-11 of the Remarks, filed 12/09/03, with respect to the rejection(s) of claim(s) 1, 20, 37, 38 and 45 under 35 U.S.C. 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nardella et al. (US 5941876) and Kresch et al. (US 5456689).

Note: Examiner agrees that Rydell does not teach or suggest the shaft coupled to the drive interface and an electrical interface as claimed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 7, 18, 20, 24, 35 and 37-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Nardella et al.

Nardella et al. disclose a surgical apparatus, comprising a surgical instrument including a housing (60) and a cannula (14), and the cannula attached at a proximal end to the housing and defining at a distal end thereof an opening and the housing containing a drive interface (col. 6 lines 38-46); and a surgical tool (10) including a shaft and a tip, and the tip located in the opening, and the shaft contained within the

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cannula and the shaft mechanically and electrically coupled (col. 5 lines 61-65) at a distal end to the tip, and at a proximal end, to the drive interface and an electrical interface, and the drive interface producing a surgical motion of the tip, and the electrical interface producing a cauterizing action of the tip. A switch (72), located on the housing. The tip includes at least one conducting portion (20) and at least one non-conducting portion (16B), and wherein the shaft is electrically coupled to the at least one conducting portion.

4. Claim 1, 3, 4, 7, 18, 20, 24, 35 and 37-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Kresch et al.

Kresch et al. disclose a surgical apparatus, comprising a surgical instrument including a housing (H) and a cannula (P), and the cannula attached at a proximal end to the housing and defining at a distal end thereof an opening and the housing containing a drive interface (col. 5 lines 3-4); and a surgical tool (C) including a shaft and a tip, and the tip located in the opening, and the shaft contained within the cannula and the shaft mechanically and electrically coupled (col. 4 line 61 – col. 5 line 25) at a distal end to the tip, and at a proximal end, to the drive interface and an electrical interface, and the drive interface producing a surgical motion of the tip, and the electrical interface producing a cauterizing action of the tip. The tip includes at least one conducting portion (20) Nardella et al. disclose a surgical apparatus, comprising a surgical instrument including a housing (60) and a cannula (14), and the cannula attached at a proximal end to the housing and defining at a distal end thereof an opening and the housing containing a drive interface (col. 6 lines 38-46); and a surgical

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tool (10) including a shaft and a tip, and the tip located in the opening, and the shaft contained within the cannula and the shaft mechanically and electrically coupled (col. 5 lines 61-65) at a distal end to the tip, and at a proximal end, to the drive interface and an electrical interface, and the drive interface producing a surgical motion of the tip, and the electrical interface producing a cauterizing action of the tip. The tip includes at least one conducting portion (20).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-13 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardella et al. Nardella et al. teach all of the limitations of the claims except the particular shapes of the conductive and non-conducting portion. To have modified the shape of the conductive portion and non-conductive portion such that they would have convex and concave surface as claimed, would have been obvious to one having ordinary skill in the art at the time the invention was made since it has been held to be within the skill level of the art that changing the shape of a structure involves only routine skill.

7. Claims 8-13 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kresch et al. Kresch et al. teach all of the limitations of the claims except the particular shapes of the conductive and non-conducting portion. To have

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modified the shape of the conductive portion and non-conductive portion such that they would have convex and concave surface as claimed, would have been obvious to one having ordinary skill in the art at the time the invention was made since it has been held to be within the skill level of the art that changing the shape of a structure involves only routine skill.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
Art Unit 3739

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